



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,076	11/14/2005	Adam Rubin	10733.0002	2551
22852	7590	02/23/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER NOGUEROLA, ALEXANDER STEPHAN	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 02/23/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,076

Applicant(s)

RUBIN ET AL.

Examiner

ALEX NOGUEROLA

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed November 23, 2009 have been fully considered but they are not persuasive.

2. *Rejection of claim 1 as being obvious over Wiktorowicz in view of Zanzucchi, Simpson, and Cahill*

While Applicant acknowledges that Cahill discloses a coating thickness falling within the range of 0.01 and 15 μm , Applicant argues that it would not have been obvious to substitute the coating of Cahill for that used by Wiktorowicz and if this substitution is made the resulting system would not be the same as claimed. In particular, Applicant asserts,

First, Cahill's system requires more buffer solution to fill the gap between the two juxtaposed surfaces as compared to Applicants' system that needs only sufficient amount of buffer to "soak" the pH active groups. Second, the molecules to be separated would experience a different electrical field within an open planar surface as in the present invention as opposed to the electrical field within a channel-like chamber as in Cahill's device. Third, the fluid dynamics established within an open planar surface is different from the fluid dynamics established within the two juxtaposed surfaces.

See page 4 of Applicant's Response received on November 23, 2009.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., amount of buffer needed, nature of the electrical field, and fluid dynamics characteristics as discussed in the quotation above) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, Applicant merely opines that the amount of buffer needed, nature of the electrical field, and fluid dynamics characteristics in the system of Wiktorowicz as modified by Cahill (and Simpson and Zanzucchi) would be different than in Applicant's invention. There is no explanation as why such differences would be expected.

Additionally, Applicant appears to argue that his invention does not require "two juxtaposed, especially opposite surfaces" as he believes is required by Wiktorowicz as modified by Cahill. However, again, Applicant argues about a feature that is not claimed. Applicant's claim 1 does not exclude a second surface opposite the first one; that is, a juxtaposed opposite surface. Moreover, there does not appear to be clear support for excluding a juxtaposed opposite surface in the original disclosure, especially since Applicant discloses that the secondary process path(s) may be subjected to centripetal force (how is fluid retained in the channel without a cover if the channel is spun around at high speeds?) and several, if not all, of the patents Applicants refers as examples of a disc shaped device have juxtaposed opposite surfaces. See specification page 11, lines 5-12 and page 13, lines 16-26, and, for example, WO 02/075775 A1 page 23, lines 26-27; and WO 97/21090 Figure 17D.

3. *Rejection of claim 1 as being obvious over Liu in view of Zanzucchi, Simpson, and Cahill*

Applicant essentially restates his arguments against using Cahill's coating as a substitute coating which were set forth against the rejection of claim 1 as being obvious over Wiktorowicz in view of Zanzucchi, Simpson, and Cahill. The Examiner is turn relies on his rebuttal above.

4. *Rejection of claim 1 as being obvious over Lee in view of Zanzucchi, Simpson, and Cahill*

Applicant essentially restates his arguments against using Cahill's coating as a substitute coating which were set forth against the rejection of claim 1 as being obvious over Wiktorowicz in view of Zanzucchi, Simpson, and Cahill. The Examiner is turn relies on his rebuttal above.

5. For the reasons set forth above all of the rejections set forth in the Office action mailed on July 23, 2009 are maintained.

Final Rejection

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (571) 272-1343. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alex Noguerola/
Primary Examiner, Art Unit 1795
February 17, 2010